

**REMARKS****Status of the Claims**

In a previous amendment, Applicants cancelled claims 2, 13 and 17. Claims 1, 3-12, 14-16 and 18-20 are currently pending in the present application.

**Issues Under 35 U.S.C. § 103**

The Examiner has rejected claims 1, 3-12, 14-16 and 18-20 under 35 U.S.C. § 103(a) as being unpatentable over Takahisa or alternatively based on the ordinary skill in the art. Applicants respectfully traverse.

As the present application explains, there is a problem associated with reading bar codes from a wide variety of video displays (paragraph 6) which range from a computer cathode ray tube (CRT) which commonly refreshes from 72 Hz to 85 Hz, to a computer liquid crystal display (LCD) which commonly refreshes at 60 Hz, to a various foreign television CRTs which commonly refresh at 50Hz to 60Hz . In the application, Applicants explain that bar codes will be presented to a user from a variety of media including: print form or internet devices (paragraph 46), a laptop LCD screen (paragraph 49), a TV broadcast seen upon a laptop computer (paragraph 72), and may other forms. Applicants' solve the problem of scanning bar codes from a wide variety of video display and media by using "a scanner operating at 100 or more scans per second" and include this limitation in independent claims 1, 9, and 16.

Takahisa did not address the problem of a wide variety of video display and media nor is there any discussion therein concerning how to solve this problem. Instead, Takahisa teaches away from the present invention by narrowly disclosing "a liquid-crystal display [LCD] on which coupon [having a bar code] may be shown" (Column 17, lines 10-12). Takahisa only discloses an LCD for bar code scanning, which as Applicants had prior noted refreshes at 60 hertz.

Therefore, there is no suggestion in Takahisa that "a scanner operating at 100 or more scans per second" must be used to read bar codes from a wide variety of video displays including LCDs.

One of ordinary skill would be not utilize "a scanner operating at 100 or more scans per second" when dealing with a LCD, as the Examiner suggested, but rather utilize a typical bar code reader which has a low scan rate of 30 to 100 scans per seconds (Applicants' application, paragraph 8) or a scanner narrowly tailored to an LCD which is synchronized with the LCD (Applicants' application, paragraph 8). In addition, Takahisa limits the disclosure to include an LCD and therefore one of ordinary skill would not be led to substitute a wide variety of video displays for the LCD disclosed. Therefore, the Applicants respectfully request the Examiner's rejections be withdrawn.

The Examiner is reminded that any suggestion or motivation to modify Takahisa must come from the prior art. While the Examiner notes the problems that previously existed in reading a bar code from a high refresh rate video display, the only suggestion for a solution comes from the present application. The Examiner has again cited no prior art that mentions or discusses using "a scanner operating at 100 or more scans per second" on a wide variety of video display. Applicants respectfully remind the Examiner of the prohibition on hindsight reconstruction and suggest the claims are now in proper form for allowance.

Moreover, the Examiner is reminded that any prior art relied upon must be enabling. In *Re Donohue*, 766 F.2d 531, 226 U.S.P.Q. 619 (Fed. Cir. 1985). The Takahisa reference merely discloses the use of conventional bar code readers, which the Examiner has found do not work. Furthermore, as seen in the Examiner Remarks, Page 3 of the 12/17/02 Office Action, the Examiner continues to offer no teachings to support a result different from the Examiner's unsuccessful experience with the Welch Allyn scanner or any information to support his belief

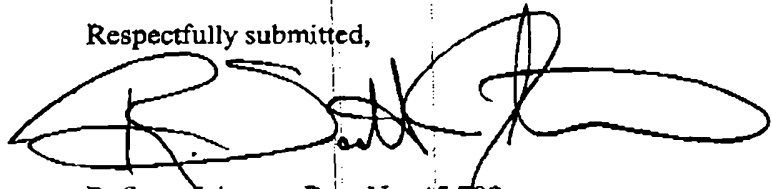
that the legacy PALM system requires compatibility with the laser scanners previously used that would have worked (i.e. laser scanner model, scan rate of scanner, etc.). As Applicants have stated throughout the specification and the § 132 Declaration, hand-held scanners must have a high scan rate, defined as more than 100 scans per second, to be capable of reading a wide variety of video displays and media. Therefore, the Examiner has failed to set forth an enabling disclosure sufficient to anticipate Applicants' invention.

### Conclusion

In light of the above, Applicants respectfully request allowance of claims 1, 3-12, 14-16 and 18-20. It is submitted that all of the claims are in allowable form. The Examiner is invited to contact the undersigned at the number indicated below should it be determined it would advance prosecution.

Please consider this a two-month extension of time and find enclosed our check for \$205.00. No other fees or extensions of time are believed to be due in connection with this amendment; however, consider this a request for an extension inadvertently omitted, and charge any additional fees to Deposit Account No. 26-0084.

Respectfully submitted,



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